

**REMARKS**

In response to the office action mailed May 5, 2008, Applicants have amended claim 7 and the specification, withdrawn claims 2, 11, and 14-17, and cancelled claims 10 and 13.

Claims 1, 3-7, 9, 10, 12, 13, and 18-20 are presented for examination.

Claims 10 and 13 are rejected under 35 U.S.C. §112, 1<sup>st</sup> paragraph as failing to comply with the enablement requirement. Applicants have cancelled these two claims.

Claim 1, 3-7, 9, 10, 12, 13, and 18-20 are objected as containing non-elected subject matter. The Examiner asserts that “[e]claims 1, 3-7, 9, 10, 12, 13, and 18-20 have been examined to the extent that they are readable on the elected embodiment, the elected species of Example 1 ... [s]ince the elected species is not allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration” and suggests that “[c]laims 1, 3-7, 9, 10, 12, 13, and 18-20 presented drawn to solely to the elected embodiment [i.e., the compound of Example 1] would overcome this objection.” *See* the office action, the paragraph bridging pages 2 and 3 and page 3, 3<sup>rd</sup> paragraph; emphases original.

Applicants note that the Examiner has cited no prior art against the elected species, i.e., the compound of Example 1. The only rejection raised in the Examiner is an non-enablement rejection of claims 10 and 13, which have been cancelled by Applicants. Applicants submit that the compound of Example 1 is now free of any rejection and is therefore patentable.

Further, in the restriction requirement dated January 16, 2008, the Examiner stated that “[i]n the event that the elected compound cannot be found [in prior art], the search and examination will be extended to include additional species.” See page 4, 2<sup>nd</sup> last paragraph. Given that the Examiner did not find the compound of Example 1 in prior art, Applicants request that the Examiner extend the search and examination to include additional species covered by pending claims 1, 3-7, 9, 12, and 18-20. Accordingly, Applicants submit that it is unnecessary to limit claims 1, 3-7, 9, 12, and 18-20 to the compound of Example 1 and that this objection is now moot.

Applicant : Judith McInally et al.  
Serial No. : 10/538,452  
Filed : June 10, 2005  
Page : 10 of 10

Attorney's Docket No.: 06275-455US1 / 100927-1P US

Please apply any charges to deposit account 06-1050, referencing Attorney's Docket No.  
06275-455US1.

Respectfully submitted,

Date: July 11, 2008

/Tony Zhang/

Tony Zhang, Ph.D.

Reg. No. L0256

Fish & Richardson P.C.  
Citigroup Center - 52nd Floor  
153 East 53rd Street  
New York, New York 10022-4611  
Telephone: (212) 765-5070  
Facsimile: (877) 769-7945  
30428630.doc